

REMARKS

This is in response to the Final Office Action mailed 4/23/99 (Paper no. 8). Claim 3 has been amended above. Claims 1-28 remain pending in this application.

The Examiner has rejected Claims 1-28 under 35 U.S.C. 103 as being unpatentable over Abdul-Halim and Hashimoto et al. and Radio Shack® EC-359 Owner's Manual (hereinafter referred to as "the Manual"). The Applicants respectfully disagree.

Claim 1 calls for:

in response to input from a user, selecting one of a plurality of directories, each of said directories being related to a respective type of communication, and

in response to another input by the user, selecting one of the displayed entries (of the selected directory) for initiating a communication (using the personal digital assistant) to a party identified by the selected entry.

Neither Abdul-Halim, nor Hashimoto, nor the Manual disclose or suggest the features recited in Claim 1. In Col. 4, lines 21-25, Abdul-Halim discloses a pager/personal organizer (PPO) 10 which includes a personal name directory 100 linked to canned or personalized messages. Fig. 6 shows a pictorial representation of the personal name directory 100 of the PPO 10 in Abdul-Halim. The personal name directory 100 has entries 102, each of which includes telephone number and address information and has a message linked therewith (Col. 4, lines 21-25). In Abdul-Halim, the PPO 10 operates in response to receiving a message that includes a telephone number by searching the personal name directory 100 to determine if the telephone number in the received message matches with a telephone number in any of the entries 102 of the directory 100. If there is a match,

the canned message linked to the entry 102 which matches the received telephone number is displayed on the PPO display (Col. 3, lines 36-43). This is not the same as the user selecting one of a plurality of directories where each directory is related to a respective type of communication as otherwise recited in Claim 1. Nowhere does Abdul-Halim appear to disclose or suggest in response to a user input, selecting one of a plurality of directories, each of said directories being related to a respective type of communication. Moreover, Abdul-Halim does not disclose or suggest that in response to another user input, selecting one of the displayed entries of the selected directory for initiating a communication to a party identified by the selected entry as is called for in Claim 1. Claim 1 reads over Abdul-Halim.

Hashimoto et al. also discloses a paging device 1 with a message display function (see Fig. 1). The paging device 1 in Hashimoto et al. has an address directory memory section 14a in which calling numbers (including area code) are registered, and in which supplemental information linked to the registered calling numbers is stored (Col. 7, lines 39-41). When the Hashimoto et al. paging device 1 receives a calling number, the received calling number is searched in the address directory 14a. If the received calling number corresponds to a registered calling number in the directory 14a, the address directory memory 14a outputs the registered number for display on the display of the Hashimoto et al. paging device 1. The address directory memory 14a then also displays the fixed message linked to the displayed registered number (e.g. a message indicating whether the displayed number is a fax number or a telephone number). In other words, Hashimoto et al. appears to disclose an address directory 14a having calling numbers registered therein, each of which has

supplemental information linked thereto which is displayed with the registered number if the paging device 1 receives a calling number which corresponds to a registered calling number in the directory 14a. This is different than the user selecting one of a plurality of directories, each directory being related to a respective type of communication as is recited in Claim 1. The paging device 1 in Hashimoto et al. does not appear to have a plurality of user selectable directories. Merely having fixed messages linked to calling numbers registered in an address directory 14a and displayed with the registered number when the paging device receives a calling number message, as in Hashimoto et al., is not the same as selecting one of a plurality of directories. Hashimoto et al. simply does not disclose or suggest the user selecting one of a plurality of directories, each directory being related to a respective type of communication as is called for in Claim 1. Moreover, nowhere does Hashimoto et al. disclose or suggest the user selecting a displayed entry for initiating a communication to the party identified by the selected entry as is also recited in Claim 1. Claim 1 clearly reads over Hashimoto et al.

On page 25, the Manual discloses that the electronic organizer (EC-359) stores telephone/business card records in alphabetical order. Page 24 of the Manual shows a telephone/business card available for display on the display of the electronic organizer. The information on the telephone/business card includes a name/company name heading with additional linked or slaved information such as telephone number (land line and cellular), facsimile number, and address. The Manual appears to disclose that the EC-359 organizer includes only a name/company name directory (see "RECALLING TELEPHONE/BUSINESS CARD RECORDS, page 25. The user can scroll alphabetically through all the card records which

implies that there is only one directory and the name and company name are merely separate fields of records included in that directory)). The Manual does not appear to disclose or suggest the user of the EC-359 selecting one of a plurality of directories. For example, on page 26 of the Manual, paragraph 2 "Recalling Telephone/Business Card Records by Name or Company", discloses that to recall a record the user types in the search letters (name or company name) and the search is performed. The user, however, does not select one directory (to perform the search) from a plurality of directories. Nowhere does the EC-359 Manual disclose or suggest the user selecting one of a plurality of directories as is recited in Claim 1, much less that each of the directories is related to a respective type of communication. Claim 1 reads over the Manual. In addition, the Manual does not disclose or suggest the user selecting a displayed entry for initiating a communication to the party identified by the selected entry as is also recited in Claim 1.

Even if Abdul-Halim, Hashimoto et al., and the Manual were combined as suggested by the Examiner, Claim 1 would remain patentable. Neither Abdul-Halim nor Hashimoto et al. nor the Manual disclose or suggest the features of the invention recited in Claim 1. Accordingly, the combination of these references would also not disclose or suggest the features called for in Claim 1. Claims 1, 2, and 12-18 are patentable over the cited prior art and should be allowed.

Claim 3 has been amended to call for:

in response to input from a user, selecting one of a plurality of directories, each of said directories being related to a respective type of communication, and

in response to a selection by the user, associating an inputted message with a selected entry of the selected directory, wherein the communication information corresponding to selected entry is assigned to the inputted

message for communicating the message to the party identified by the identification information corresponding of the selected entry.

Neither Abdul-Halim, nor Hashimoto et al., nor the Manual disclose or suggest the features recited in Claim 3. As mentioned previously in reference to Claim 1, Abdul-Halim does not disclose or suggest the user selecting one of a plurality of directories. In addition, Abdul-Halim does not disclose or suggest in response to a selection by the user, associating the inputted message with a selected entry of the selected directory wherein the communication information corresponding to the entry is assigned to the message for communicating the message to the party corresponding to the entry. Rather, the PPO 10 in Abdul-Halim merely operates to display a canned message linked to a telephone number entry 102 which matches a telephone number message received by the PPO 10. Nowhere does Abdul-Halim disclose or suggest that communication information of a selected entry is assigned to an inputted message for communicating the message to a party identified by the selected entry as is otherwise called for in Claim 3.

As stated earlier with reference to Claim 1, Hashimoto et al. appears to disclose a paging device 1 which, in response to the device 1 receiving a calling number message corresponding to a calling number registered in the device 1, merely displays the registered calling number including area code and a fixed message linked to the registered number. Hashimoto et al. does not disclose or suggest the user selecting one of a plurality of directories as called for in Claim 3. In addition, nowhere does Hashimoto et al. disclose or suggest that communication information corresponding to a selected entry is assigned to an inputted

message for communicating the message to a party identified by the selected entry as called for in Claim 3.

The Manual appears to disclose an organizer in which a user can search a name/company name directory for card records which may be displayed. However, the Manual does not appear to disclose or suggest the user selecting one of a plurality of directories much less that communication information corresponding to a selected entry of the selected directory is assigned to an inputted message for communicating the message to a party identified by the selected entry as is otherwise called for in Claim 3.

Being that neither Abdul-Halim, nor Hashimoto et al., nor the Manual are seen to disclose or suggest the above mentioned features of Claim 3, a combination of these references would also not disclose or suggest these features. Therefore, the Applicants respectfully submit that Claims 3-5 and 19-22 are patentable over the cited prior art and should be allowed.

Claim 6 calls for a personal digital assistant (PDA) comprising electronic communication means for initiating an electronic communication to the party identified by the identifier defined by data elements of the selected record.

Neither Abdul-Halim, nor Hashimoto et al., nor the Manual disclose or suggest the features recited in Claim 6. The PPO 10 in Abdul-Halim merely receives a message and displays a canned message in response to the received message (Col. 3, lines 36-43). Abdul-Halim does not disclose or suggest that the PPO 10 has electronic communication means for initiating an electronic communication to a party as called for in Claim 6. Hashimoto et al. discloses that the paging device 1 is capable of receiving a calling number and of

displaying the corresponding number registered in the memory of the device 1. Hashimoto et al. also does not disclose or suggest that the paging device 1 has electronic communication means for initiating an electronic communication to a party as called for in Claim 6. The Manual appears to disclose an organizer having card records stored therein which a user can search and display on a display of the organizer. Nowhere does the Manual disclose or suggest that the EC-359 organizer has electronic communication means for initiating an electronic communication to a party as called for in Claim 6. Neither Abdul-Halim, nor Hashimoto et al., nor the Manual disclose or even suggest the features recited in Claim 6, and hence, the combination of these references would still not disclose the features recited in Claim 6.

The Examiner cites no reference which discloses or suggests a personal digital assistant (PDA) having electronic communication means for initiating an electronic communication to the party identified by the identifier defined by data elements of the selected record. Yet the Examiner appears to argue, on page 4 of the Office Action, that it would have been obvious to a person skilled in the art to provide a PDA with electronic communication means for initiating an electronic communication with the party identified by the identifier in the record selected by the user. The Applicants respectfully disagree. Although the Examiner's discussion is not clear, the basis of the Examiner's argument appears to be that, according to the Examiner, it would be obvious to one skilled in the art to provide a paging device (as in Hashimoto et al., or Abdul-Halim) with a transmitter so that the user may communicate with a paging party, and hence, it would also be obvious to add communication means to a PDA. The Examiner then uses the telephone as an analogy, noting that the

telephone has both a speaker end (receiver) and a speaking end (transmitter).

First, the Applicants respectfully note that the telephone is not analogous to the instant invention. Under 35 U.S.C. 103, a reference is analogous if:

- 1) the reference is in the same field of endeavor as the applicants'; or
- 2) the reference is reasonably pertinent to the particular problem with which the applicant was concerned. (see In re Oetiker, 977 F.2d 1443 (Fed. Cir. 1992))

A telephone is clearly not in the same field of endeavor as the personal digital assistant of the instant invention. Nor is the telephone reasonably pertinent to the particular problem with which the Applicants were concerned. The Applicants were concerned with providing a personal digital assistant enabling a user to almost instantaneously find the identifier of a selected party which the user wishes to electronically communicate with and almost instantaneously initiate the desired communication to that party. A telephone is clearly not reasonably pertinent to that problem. Thus, simply because a telephone has both a speaker end and a speaking end does not render it obvious to one skilled in the art to add electronic communication means to a PDA for initiating an electronic communication with a party identified by the identifier in a record selected by the user.

Second, even if it were obvious to one skilled in the art (though the Applicants' maintain that it is not) to provide a paging device with a transmitter for communicating with a paging party, the Applicants' invention of a PDA with communication means for initiating an electronic communication

to the party identified by the identifier in the record selected by the user is much more than merely a paging device which has a transmitter for transmitting to the paging party. In contrast to a paging device (as disclosed in Hashimoto et al., and Abdul-Halim), the PDA of the present invention is adapted to allow a user to select any desired party from a selected directory, of a plurality of directories, which corresponds to the type of electronic communication with which the user will communicate with the selected party. Thus, in the present invention the user is not merely responding to the paging party. In addition, the plurality of selectable directories in the PDA of the present invention, each of which corresponds to a type of electronic communication, allow the user to almost instantaneously find the selected party's communication information for the desired communication type and the immediately initiate the communication. The PDA of the present invention need not search and display all the information on the contact card of each party stored in the PDA. Rather, the PDA searches and displays the identifiers of the parties in the directory selected by the user corresponding to the desired type of communication. This substantially reduces the processing performed by the PDA, allowing reductions in processing time as well as in processor size with corresponding reductions in power demands and cost of the PDA. In addition, after the user inputs a message and selects the desired party, communication information for the selected party can be almost instantaneously assigned to the message for initiating communication of the message to the selected party. This is not disclosed or suggested anywhere in the cited prior art, and it would not have been obvious, without more, to one skilled in the art to modify the paging device disclosed in Hashimoto et al., and Abdul-Halim to provide as in the present invention a PDA comprising communication means for initiating

an electronic communication to the party identified by the identifier in the selected record. Claims 6-11 and 23-24 are patentable over the cited prior art and should be allowed.

Claim 25 calls for a personal digital assistant (PDA) comprising control means responsive to receiving user-inputs specifying that a first one of a plurality of directories be selected, and also being responsive to receiving user-input information specifying that one of the displayed directory entries be selected for controlling the communication means so as to initiate a communication to the party identified by the selected directory entry.

Similar to the previous discussion with respect to Claims 1, 3 and 6, the Applicants respectfully reiterate that neither Abdul-Halim, nor Hashimoto et al., nor the Manual disclose or suggest a PDA comprising control means responsive to receiving user-inputs specifying that a first one of a plurality of directories be selected, and also being responsive to receiving user-input information specifying that one of the displayed directory entries be selected for controlling the communication means so as to initiate a communication to the party identified by the selected directory entry as called for in Claim 25. Claims 25-28 are patentable over the cited prior art and should be allowed.

The claim amendments presented herein further clarify the subject matter in the claims and present no new issues. Thus, the Applicants respectfully submit that this Amendment should be entered. Claims 1-28 of this Application are now deemed to be in condition ready for allowance. For all of the foregoing reasons, it is respectfully submitted that all of the claims now present are clearly novel and patentable

over the prior art of record. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issue remain, the Examiner is invited to call Applicants' Attorney at the telephone number indicated below.

Respectfully submitted,

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7/15/99

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